

### **Remarks**

Reconsideration of the subject application is requested in view of the foregoing amendments and the following remarks.

Claims 5, 7-10, 16, 19-21, 27, 30-32 are the subject of the Office action. In this paper, composition claims 5, 7-9, 27, and 31 are amended, and composition claims 16 and 19-21 are canceled without prejudice.

In addition, a request for rejoinder of certain method claims, depending from the remaining composition claims, is hereby made. Also requested are certain amendments, set forth herein, to those rejoined claims. Specifically:

(a) Method claims 41 and 49-53, which were previously withdrawn, are amended and identified herein as “Withdrawn and Currently Amended.”

(b) Method claims 43, 47, 55, 56, 57, 58, and 60, which were previously withdrawn, are unchanged and identified herein as “Withdrawn and Original.”

Therefore, entry of this amendment will result in the following claims being pending: 5, 7-10, 27, 30-32, 41, 43, 47, 49-53, 55-58, and 60.

No new matter has been added by these amendments. Applicants expressly reserve the right to pursue protection of any or all of the canceled subject matter in one or more continuing applications as Applicants see fit.

#### ***Request for rejoinder***

Applicants thank the Examiner for the interview with the undersigned on November 26, 2007. During that interview the allowability of claims directed to the nucleic acid sequences (claims 5, 7-10, 16, 27 and 30-32) was discussed, and the Examiner indicated that these claims, as amended herein, would be allowable. Support for these amendments can be found on page 22, lines 10-15, of the specification (see the corresponding PCT publication).

During the interview, rejoinder of certain method claims depending from the allowable composition claims was also discussed. The Examiner provided helpful comments relating to possible amendments to claim 41 that may put claim 41 and its dependent claims in condition for allowance. Accordingly, Applicants have amended claim 41. Support for these amendments can

be found on page 40, lines 13-40 of the specification (see the corresponding PCT publication). These dependent methods claims depend from allowable claims and do not raise new issues or introduce any new matter. Hence, Applicants respectfully request that the subject method claims be rejoined and allowed.

Similarly, Applicants have amended claims 51-53, 55-58, and 60 to depend from the allowable composition claims and request rejoinder of these claims to the instant application. These claims relate to the use of the nucleic acid molecule according to claim 5 to increase paclitaxel yield in a cell and do not raise new issues or introduce new matter. Hence, Applicants respectfully request that the subject method claims be rejoined and allowed.

### ***Rejections Under 35 U.S.C. § 112***

The Office rejected claim 7 because of the use of the language “as set forth in” and requested that this language be changed to “of.” To facilitate prosecution Applicants have amended claim 7 accordingly.

The Office also rejected claim 16, and claims 19-21 depending from claim 16, for alleged indefiniteness. Applicants disagree, but to expedite prosecution have canceled these claims herein without prejudice.

The Office also rejected claims 5, 7-10, 16, 19-21, 27, and 30-32 for alleged lack of enablement. Applicants disagree, but to expedite prosecution have amended these claims to be directed to sequences having 95% sequence identity with SEQ ID NOS: 1 and 2. Therefore, the genus of sequences encompassed by these claims has been reduced, and the analysis performed by the Examiner applying the *Wands* factors (*In re Wands*, 858 F.2d 731, Fed. Cir. 1988) to this rejection is now moot. Accordingly, Applicants respectfully request that this rejection be withdrawn.

### ***Rejections Under 35 U.S.C. § 102(b)***

The Office rejected claims 5, 7-10, 16, 19-21, 27, and 30-32 for alleged anticipation by Croteau et al. (§ 102(a), citing WO01/34780, or § 102(e), citing U.S. Patent No. 6,787,343). In light of the amendments described herein relating to enablement, this rejection is no longer proper. Therefore, Applicants request that this rejection be withdrawn.

**Conclusion**

It is respectfully submitted that the present claims are in condition for allowance, and early action to such end is requested.

If any issues remain, the Examiner is requested to contact the undersigned attorney prior to issuance of the next Office action in order to arrange a telephone interview. It is believed that a brief discussion of the merits of the present application may expedite prosecution and allowance of the claims.

Respectfully submitted,

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